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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/542,566	10/13/95	HEUER L	BAYER-8890.2

ROBINSON, A — EXAMINER

12M2/0311

ART UNIT	PAPER NUMBER
1209	

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DATE MAILED: 03/11/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 7 and 11 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 7 and 11 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☒ been filed in parent application, serial no. 08/128,450 ; filed on 9/28/93.

13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

The status of SN: 08/338,356, filed 11/14/94 should be indicated in the specification.

The amendment filed 10/13/95 has been entered.

Claim 11 is rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is an improper claim in claiming products that merely contain the claimed active ingredient.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 7 and 11 are rejected under 35 U.S.C. § 103 as being unpatentable over Schaub (A) in view of Ludwig et al. (A'), and European Patent 0,393,846 (L') all of record. Rationale: The Schaub reference teaches that cyproconazole is an old fungicide employed with carriers of the type claimed. The Schaub reference also discloses that the claimed azole is effective against fungi in the same class. See col. 5, lines 52-53.

The EPO reference and the Ludwig et al. reference teaches that triazoles of the type claimed are old fungicide employed with carriers of the type claimed and effective against wood fungi.

Therefore, one skilled in the art would find ample motivation from the prior art supra to use cyproconazole as a fungicide against the target fungi on wood of the instant application with a reasonable expectation that said cyproconazole would be effective to combat said target fungi especially since said cyproconazole is an old fungicide and similar triazoles of the secondary references are effective against wood fungi. In view of the above prior art the instant claims are deemed unpatentable.

Applicants' arguments and the declarations by Dr. Martin Kugler have been carefully considered; however, they are not deemed persuasive. The declarations by Dr. Martin are insufficient to overcome the above rejection since the claimed compound is an old fungicide; effective against the same type of fungi, therefore nothing unexpected is seen.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM.

The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

ALLEN J. ROBINSON
PRIMARY EXAMINER
GROUP 1200

ROBINSON; aco
March 8, 1996